

Atty Dkt. No.: 10010011-1
USSN: 09/775,163

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-14, 16, 25-34 and 37, as well as newly introduced Claims 43 to 55, the only claims pending and currently under examination in this application.

New claims 43 to 55 find support in the originally filed claims. As the above new claims introduce no new matter to the application, their entry by the Examiner is respectfully requested.

Claims 1-3, 16, 25-27 and 37 have been rejected under 35 U.S.C. § 102 (b) as being anticipated by Yang.

It is noted that Yang was published in November 2000 and that the filing date of the present application was January 31, 2001. Accordingly, Yang was not published more than one year prior to the filing date of the present application. Therefore, Yang does not qualify as prior art to the present application under 35 U.S.C. § 102 (b). It is believed that the Examiner meant to make this rejection under 35 U.S.C. § 102 (a). The rejection will therefore be responded to as though the rejection were made under 35 U.S.C. § 102 (a).

As stated in MPEP 2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

All of the claims of this rejection include the step of "saving the displayed shapes in a first file and the processed results in a second file." The Examiner does not point out in the rejection where this step is found in the Yang reference. Furthermore, a review of the Yang reference has failed to identify where this step of the claimed method is disclosed.

Accordingly, it is respectfully submitted that Yang fails to teach at least this element of the claims, in which the shapes are saved in a first file and the processed

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results are saved in a second file. Because Yang fails to teach at least this element, Yang does not anticipate these claims. Accordingly, the rejection of Claims 1-3, 16, 25-27 and 37 under 35 U.S.C. § 102 (a) as being anticipated by Yang may be withdrawn.

Claims 1-14, 16, 25-34 and 37 have been rejected under 35 U.S.C. § 102 (b) as being anticipated by Genepix.

It is noted that Genepix was published in November 2000 and that the filing date of the present application was January 31, 2001. Accordingly, Genepix was not published more than one year prior to the filing date of the present application. Therefore, Genepix does not qualify as prior art to the present application under 35 U.S.C. § 102 (b). It is believed that the Examiner meant to make this rejection under 35 U.S.C. § 102 (a). The rejection will therefore be responded to as though the rejection were made under 35 U.S.C. § 102 (a).

As stated in MPEP 2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

All of the claims of this rejection include the step of "saving the displayed shapes in a first file and the processed results in a second file." The Examiner does not point out in the rejection where this step is found in the Genepix reference. Furthermore, a review of the Genepix reference has failed to identify where this step of the claimed method is disclosed.

Accordingly, it is respectfully submitted that Genepix fails to teach at least this element of the claims, in which the shapes are saved in a first file and the processed results are saved in a second file. Because Genepix fails to teach at least this element, Genepix does not anticipate these claims. Accordingly, the rejection of Claims 1-14, 16, 25-34 and 37 under 35 U.S.C. § 102 (a) as being anticipated by Genepix may be withdrawn.

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CONCLUSION

The applicant respectfully submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Dianne Rees at 650 485 5999. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: 12.20.04

By: 

Bret E. Field
Registration No. 37,620